

Appi. No. 10/086,294  
Response to Restriction Requirement faxed 01 March 2005  
in Reply to Restriction Requirement of February 1, 2005

PATENT

### REMARKS/ARGUMENTS

Claims 1, 3-5, 9-22, 25-40, 78, and 79 are pending in the present application. Claims 2, 6-8, 23, 24, and 41-77 were previously canceled. In response to the Restriction Requirement mailed February 1, 2005, Applicant elects to prosecute the claims of Restriction Group IV with traverse.

#### TRAVERSE

Applicant respectfully requests that Groups II, IV, and VI be grouped together. It is well established that restriction is only proper when search and examination is "a serious burden on the examiner." See MPEP §803.

Each of the Groups relates to a combination treatment with p53 tumor suppressor nucleic acid a microtubule affecting agent. Group II relates to p53 nucleic acid administration prior to microtubule affecting agent administration. Group IV relates to p53 nucleic acid administration subsequent to microtubule affecting agent administration. Group VI relates to p53 nucleic acid administration simultaneous with microtubule affecting agent administration. The Restriction Requirement says each of these Groups is classifiable in class 514, subclass 44.

According to the Restriction Requirement, searches of each method are not coextensive and would require different key word searches in divergent patent and non-patent literature databases, and would require, at least, searches of distinct method steps related to the specific order of administration. The Requirement also alleges such searches would require subsequent in-depth analysis to the extent of placing a serious burden on the Office in terms of both search and examination. Applicant disagrees.

Applicant submits that there is no undue burden on the Examiner to consider Group II, IV, and VI claims together. Applicant submits that due to the relationship between these groups, it is natural and desirable to conduct the search in connection with examination of the claims of Groups II, IV, and VI; indeed, simultaneous prosecution of the Groups would be more efficient. Absent evidence to the contrary, Applicant submits that a key word search for any one of these groups would be very similar, if not identical, to a keyword search for either of

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the other two groups. What is more, Applicant cannot envisage a specific analysis with regard to the administration sequence of any one of these groups that would not require a concurrent analysis with regard to the administration sequence of the other two groups.

Applicant submits that the Restriction Requirement fails to provide a reason or an example to support a conclusion that these claims must be examined separately. The Restriction Requirement does not show that Groups II, IV, and VI are subject to separate classification, have separate status in the art, or include different fields of search. Thus, a *prima facie* case of serious burden has not been made under MPEP 803.

### CONCLUSION

Applicant thus requests that the Office reconsider the Restriction Requirement, and recombine Groups II, IV, and VI into a single group. In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,



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